

REMARKS

Claim 21–38 are pending in the present application following amendment as requested herein.

Claim 21, from which all other claims directly or indirectly depend, is amended to recite with greater clarity that the “differing tactility” of the pieces in the kit arises from using as surface layers “a plurality of soft fabrics that are distinguishable by touch” and/or from the presence of “subsurface layers that are distinguishable by touch through a lightweight surface fabric”. While a reading of the specification as a whole would have rendered clear this meaning of “differing tactility” as used in Claim 21, the claim as previously presented, if read in isolation, could possibly have been misconstrued to read on use of a kit wherein differing tactility was a function only of the shapes of the pieces. Support for the present amendment of Claim 21 is found in the specification as filed at least at page 3, lines 8–11.

New Claim 38 is added to point out with greater specificity an embodiment of the invention wherein the “differing tactility” is provided at least in part by the soft fabric surface layers. Support for this claim is found in the specification as filed at least at page 3, lines 15–16.

Claims 32 and 33 are amended as to dependency only.

No new matter is introduced by any amendment proposed herein, and no change in inventorship results therefrom.

One dependent claim is added by this amendment, but the total number of claims does not exceed 20. Thus no additional claim fees are believed due as a result of this amendment.

RESPONSE TO OFFICE ACTION DATED MARCH 22, 2005

1. Rejection under doctrine of obviousness-type double patenting.

Claims 21, 22, 26–30 and 33–37 stand rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 2 and 7 of U.S. Patent No. 6,626,678, which is the parent of and is commonly owned with the present application. This rejection is maintained from the previous Office Action dated June 24, 2004 due to non-payment of the fee for filing a Terminal Disclaimer.

Applicant submitted a Terminal Disclaimer on September 7, 2004; but, through inadvertent error which was without deceptive intent, the undersigned omitted to enclose

remittance of the fee required under 37 C.F.R. §1.20(d). When this error was brought to Applicant's attention, Applicant immediately submitted by fax, on March 18, 2005, Form PTO-2038 providing credit card information for payment of the fee in the amount of \$65. Unfortunately, it appears this authorization was received by the Office too late to affect the present Action. The authorized amount has not been charged.

Accordingly, a new Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c) is submitted herewith, together with a United States Postal Service money order in the amount of \$65 in payment of the required fee. Form PTO-2038 submitted on March 18, 2005 is hereby revoked.

Withdrawal of the present double patenting rejection is respectfully requested.

2. Rejection under 35 U.S.C. §103(a) over Foresman in view of Monson.

Claims 21–24, 26 and 33–37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Foresman (U.S. Patent No. 5,865,627) in view of Monson (U.S. Patent No. 5,090,935). This rejection is respectfully traversed.

It is well established that a *prima facie* case of obviousness requires that all three of the criteria set forth in MPEP §2143 be met. A *prima facie* case of obviousness cannot be sustained in the present situation, for failure to satisfy at least two of the three criteria, as more fully described below.

2.1. No suggestion or motivation to combine reference teachings.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” MPEP §2143.01, citing *In re Kotzab*.

The problem to be solved in the present invention is related to improving quality of life for sufferers from dementia (Specification, page 1, lines 18–19) and the present claims specify “an adult subject having a medically diagnosed dementia”. By contrast, Foresman's device is a

teaching aid specifically designed to teach mathematics “to elementary school children, in particular” (Foresman, column 1, lines 6–7), and Monson’s toy is likewise addressed to children. See the description of the “gist” of the Monson invention (Monson, column 3, lines 21–29, emphasis added):

“Thus, the gist of the present invention is that of providing a useful and entertaining composite toy which is formed of a plurality of useful and entertaining component toys which are interconnectable to form the composite structure, wherein both the component toys and the composite toy comprise readily recognizable shapes which are attractive, entertaining and preferably educational to children of appropriate ages.”

In at least one stated object of the Monson invention, the addressees are “young children” (Monson, column 3, lines 60–65).

One of ordinary skill at the time of the present invention, seeking a solution to the problem of “entertaining and providing an activity focus to dementia patients” (Specification, page 1, lines 28–29), more specifically adult dementia patients as recited in Claim 21, would not have been motivated to combine Foresman’s teaching, such as it is, with a reference to a toy that, like Foresman’s device, is directed at children.

Thus no suggestion or motivation can be found to combine the reference teachings.

2.2. All claim limitations not taught or suggested.

2.2.1. Use to provide a therapeutic benefit to an adult dementia patient.

Claim 21 defines not only a kit to be used according to the therapeutic method of that claim, but further specifies that the method comprises “causing an adult subject having a medically diagnosed dementia to use as a cognitive activity aid” such a kit. Furthermore, Claim 21 recites that said use provides a therapeutically beneficial cognitive challenge appropriate to the mental acuity of such a subject, *i.e.*, an adult subject having a medically diagnosed dementia. All other pending claims depend from Claim 21, thus embody all limitations of Claim 21.

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” MPEP §2143.03, citing *In re Wilson*. It is respectfully pointed out that the Examiner has focused on the kit itself and ignored the method of use of the kit, which a reading of Claim 21 as a whole will show is the subject matter for which patent is presently sought.

The combination of Foresman and Monson, even if such combination were proper (which

is not admitted herein), contains no teaching or suggestion of use of their subject articles as a cognitive activity aid for adult subjects having a medically diagnosed dementia, as presented in Claim 21.

The Office Action (paragraph bridging pages 3 and 4) states that “[t]he type of user in the claimed invention is considered not to further the invention as claimed as a user of Foresman’s invention is capable of being an adult subject having a medically diagnosed dementia.” No support is given for this assertion and none can be found in Foresman, who, as pointed out above, directs his invention to schoolchildren. Further, Foresman’s device is said to be a “teaching aid” (Foresman, column 1, line 6), *i.e.*, providing educational benefit to children, and Monson’s toy is said to be “attractive, entertaining and preferably educational to children” (Monson, column 3, lines 27–28). Nowhere is it suggested, as recited in present Claim 21,

- that the Foresman or Monson articles can be therapeutic,
- more particularly that their use can provide a therapeutically beneficial cognitive challenge appropriate to the mental acuity of an adult subject having a medically diagnosed dementia, or
- that their use is as a cognitive activity aid, which can be understood from the present specification as a whole to be an article having one or more benefits specific to cognitively impaired subjects. See, for example, the listing of such benefits in the specification at page 5, line 14 to page 6, line 5, which are distinguishable from the educational benefits proposed by Foresman and Monson for their respective articles.

As stated in the present specification, at page 1, lines 24–27, “[s]imple children’s toys ... can sometimes provide entertainment but are usually not well adapted to the particular needs of people whose mental and sensory faculties are in decline rather than in development” (emphasis added).

Thus, contrary to the assertion in the Office Action, the nature of the user is one of several features breathing life into the present claims. The entire invention as presently claimed is predicated on use of the recited kit to provide therapeutic benefit to a well defined population having need of such therapeutic benefit. And neither that use nor that population is even hinted at in Foresman or Monson.

2.2.2. Differing tactility arising from surface or subsurface layers.

Claim 21 as amended herein specifies that the pieces useful in the present method “have (i) surface layers formed collectively of a plurality of soft fabrics that are distinguishable by touch and/or (ii) subsurface layers that are distinguishable by touch through a lightweight surface fabric.” This recitation, replacing the previously presented recitation of “differing tactility”, points out with greater clarity than before that a key property of the pieces is that they can be distinguished by touch based on their surface texture or the compressive resilience of a subsurface layer. Pieces distinguishable by touch solely by their shape or size would not meet this criterion. All other pending claims depend from Claim 21, thus embody all limitations of Claim 21.

It is pointed out in the Office Action (paragraph bridging pages 3 and 4) that Foresman’s pieces “collectively exhibit differing tactility when handled (due to different shapes)”. However, Foresman’s pieces appear all to be made of the same material (foam) and do not have a plurality of soft fabric surfaces by which they can be distinguished nor do they have a soft fabric surface layer through which differing subsurface layers can be distinguished.

Monson’s “pieces” (the three component toys) can have a “soft exterior surface made of a fabric such as felt or the like” (Monson, column 3, lines 8–9). Further, “the individual components ... may be made of other materials, such as soft plastics, rubber-like materials, and other such materials which facilitate safe enjoyment by children” (Monson, column 3, lines 9–13). However, nowhere does Monson contemplate using different surface fabrics that might be distinguishable by touch in making different pieces within the same “kit” (composite toy).

Thus pieces having “surface layers formed collectively of a plurality of soft fabrics that are distinguishable by touch and/or subsurface layers that are distinguishable by touch through a lightweight surface fabric”, as recited in Claim 21 as amended herein, are not taught or suggested by a combination of the Foresman and Monson references. Simply “incorporat[ing] a plurality of pieces that individually have a surface layer formed of a soft fabric into the education system kit of Foresman, in light of the teaching of Monson” (Office Action, page 4, first full paragraph) would not lead to a kit as defined in Claim 21.

In summary, the reference teachings, even if motivation could be found to combine them, would not lead one of ordinary skill in the art to the present invention, as not all claim limitations

are taught or suggested by a combination of the references.

Each of Claims 22–24, 26 and 33–37 depends from Claim 21. As Claim 21 is believed to be non-obvious over Foresman in view of Monson for reasons set forth above, all claims dependent therefrom are likewise non-obvious over the cited references.

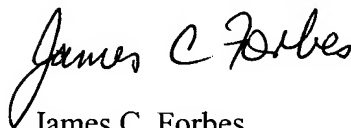
For at least the reasons set forth above, Applicant respectfully submits that a *prima facie* case of obviousness has not been made, and requests withdrawal of the present rejection under 35 U.S.C. §103(a).

3. Allowable subject matter.

It is noted that Claims 25, 31 and 32 have been found allowable, subject to their rewriting in independent form including all of the limitations of the base claim and any intervening claims.

Applicant elects once again to defer amendment of these claims for allowance, pending reconsideration by the Examiner of the rejected base and intervening claims, in light of Applicant's submission herein. Applicant believes the present application is in condition for allowance of all pending claims.

Respectfully submitted,



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Attachments:

Terminal Disclaimer
Fee under 37 C.F.R. §1.20(d)